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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/026,965

Applicant(s)

JANDA, STEVEN R.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-22 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-22,29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's amendment of 12/21/05 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 16-18,20,21,29,30, are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. (20020118111).

For claim 16,20,29, Brown discloses a first and second secure areas. The limitations of the first secure area and 2<sup>nd</sup> secure areas are considered to be satisfied by simply any plurality of areas in the secure room 100. Applicant has recited secure areas and this language is broad enough to read on two areas of room 110, such as a first area that is located in the area where a customer enters room 110, and the 2<sup>nd</sup> secure areas are the areas where the item(s) are located that are being removed. The program disclosed in paragraph 29 satisfies the limitation of a rental component that generates a list of removed items. This program also satisfies the limitation of the return component. The rental component and return component (partial return component) are the respective portions of the program discussed in paragraph 29 that accomplish the recited functions of tracking and logging removed and returned items.

Art Unit: 3629

The access controller is 170. The invoice component of the software that allows a customer to be billed. Brown discloses that the overall system of his invention can bill the customer for removed items. This satisfies what has been claimed. Brown discloses the structure recited in the claims.

For claims 17,18,21,30, see paragraphs 23 and 24 where the claimed limitations are disclosed.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,2,5-15,19,22,31,32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (20020118111).

For claims 1,7,8,9,13,15,31,32, Brown discloses a method of managing rental equipment. See paragraph 20 where the tracking of items that are occasionally removed on a temporary basis is disclosed. Brown specifically discloses the use of the invention in rental stores (for rental items such as videos). Brown discloses a storage room 100 (or 110). The room is kept secure by a locking mechanism 170 that selectively provides access to the room based on a sensed identity of a customer attempting to enter the secure room. See paragraph 25. With respect to the limitation of storing a list of rental items removed by a customer, Brown discloses that the rental items are tracked and removed items are logged in a database along with the ID of the

Art Unit: 3629

customer who removed the items. The limitations of the first secure area and 2<sup>nd</sup> secure area are considered to be satisfied by simply two areas in the secure room 100. Applicant has recited two secure areas and this language is broad enough to read on two areas of room 110, such as a first area that is located in the area where a customer enters room 110, and the 2<sup>nd</sup> secure area is the area where the item(s) is located that is being removed. Both areas are secure areas because of the locking mechanism 170 that provides secures the room 100. The language reciting that the 2<sup>nd</sup> secure area is assigned to the customer has been considered but is not taken as a method step, and does not appear to be reciting any further structure that is used in the claimed method. Because Brown discloses that one can reserve items in advance (see last few lines of paragraph 30), any area that contains a reserved item can be considered as "assigned to the customer" because it has been reserved (i.e. assigned to the customer). Brown discloses that the locking mechanism 170 senses the identity of the customer and selectively provides access as claimed. See paragraph 25. When the customer is granted access to room 100, this is providing access to both the 1<sup>st</sup> and 2<sup>nd</sup> secure areas at the same time; therefore, this satisfies what has been claimed. Brown discloses that when items are returned to the secure room 100, items that are returned are logged as being returned in the database. See paragraph 29 where the tracking of items that are removed and returned are logged. Not specifically disclosed is the step of determining what item(s) have not been returned and storing the item along with an identifier of the customer. Because Brown discloses that the invention can be used in rental stores, it would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 3629

invention was made to determine whether or not a customer has returned all rented items that the customer has previously removed, and if an item is missing, it would have been obvious to store the missing item along with the customer ID. In the business of doing rentals, one of ordinary skill in the art would most assuredly be concerned with missing inventory that has not been returned. If a customer fails to return a rented video from a video rental store, the owner would want to know this fact, so that the customer can be contacted and possibly billed for the rented but not returned video.

For claim 8, in addition to that immediately above, not disclosed is the act of alerting the customer to return the missing item(s). It would have been obvious to one of ordinary skill in the art at the time the invention was made to alert the customer to the fact that they have not returned an item that they rented. The alert can be a telephone call or a letter notifying them of their failure to return the rented item. One of ordinary skill in the art would be motivated to alert the customer so that the item can be returned and made available to another customer for rental. The examiner believes that this would be within the knowledge of one of ordinary skill in the art. Additionally, the instant examiner has personally worked in a video rental store and has personally been involved with the calling of customers on the phone to ask them to return movies that have not been returned. The examiner takes "official notice" that the act of alerting customers to the fact that they have neglected to return a rented item is old and well known in the art, and was in public use much prior to the filing date of the instant application. Claim 8 has been rejected based on what one of ordinary skill in the art

Art Unit: 3629

would have appreciated, as well as being rejection based on the “official notice” of the examiner.

For claim 2, see the last few lines of paragraph 30, where it is disclosed that the customer can reserve an object in inventory. This satisfies what has been claimed because a reservation is the same as securing the items for that customer.

For claims 5,6,11,12, Brown discloses that video cameras can be used to monitor a customer and the items they remove from a rental store. See paragraph 24. To do this the recording device must inherently be started when a customer is present in the store (after ID has been checked). Not disclosed is that the recording will stop after a predetermined amount of time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to stop recording after a predetermined amount of time has elapsed after the customer has exited the store, there is no need to record the area when nobody is there. The recording must stop at some point and having it stop after a predetermined amount of time has elapsed is considered obvious.

For claims 10,14, the recorded status information is interpreted to be any information relevant to the items and their return. Status information is broad language and is satisfied by Brown because Brown records information on what was returned, when, and by whom.

For claim 13,31, in addition to that disclosed previously, not specifically disclosed is that the customer will be billed for the item that was not returned. One of ordinary skill in the art at the time the invention was made would have been motivated to bill the

Art Unit: 3629

customer for items that are not returned so that the rental business owner would not be losing inventory without proper compensation. Not returning rented items basically is theft and one of ordinary skill in the art would be motivated to bill the customer for the items they have kept in their possession.

For claims 19,22, not disclosed by Brown is the GPS sensor. Brown discloses in paragraphs 23 and 24 that any known manner of tracking objects (and their location) can be used in the invention. Brown does not disclose a GPS sensor. Because GPS is an old and well known manner of tracking objects, one of ordinary skill in the art at the time the invention was made would have been motivated to use GPS as a manner of item tracking because GPS is widely recognized as a very accurate way of tracking items and would allow item tracking in areas other than the secure room 100. GPS works everywhere in the United States.

5. Applicant's arguments with respect to claims 1;2,5-22,29-32, have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL  
PRIMARY EXAMINER